



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/122,740	07/27/1998	KAZUHIRO TOMIZAWA	614.1907	4749

21171 7590 09/23/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

FLEURANTIN, JEAN B

ART UNIT PAPER NUMBER

2172

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/122,740	Applicant(s) TOMIZAWA, KAZUHIRO	
	Examiner JEAN B. FLEURANTIN	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,12,14-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-8 is/are allowed.
- 6) ☒ Claim(s) 12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This in response to the amendment filed on 9 June 2004, in which claims 1, 3-8, 12, 14-16 and 18-22 remain pending for examination.

Election/Restrictions

2. Newly submitted (and amended) claims 18-22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: a volatile or non-volatile computer-readable storage storing a file system, the file system comprising: two or more executable application files each stored at different respective address in the storage; two or more hierarchical directory structures comprising hierarchically linked directory structure nodes. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

During a telephone conversation with Mr. James T. Strong (Reg. No. 48,702) on 16 September 2004 a provisional election was made to prosecute (Group I) claims 1, 3-8, 12, 14-16. Accordingly, (Group II) claims 18-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Therefore, claims 1, 3-8, 12 and 14-16 remain pending for further examination.

Information Disclosure Statement

4. The information disclosure statement (IDS) filed 3/19/04 complies with the provision of M.P.E.P. 609. It has been placed in the application file. The information referred to therein has been considered as to merits. (See attached form).

Response to Applicant' Remarks

5. Applicant's arguments, filed 9 June 2004, with respect to the rejection(s) of claim(s) 1 and 3-8 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, claims 12, and 14-16 upon further consideration, a new ground(s) of rejection is made based on U.S. Patent No. 5,661,800 issued to Nakashima et al. ("hereinafter Nakashima") in view of U.S. Patent No. 5,423,034 issued to Cohen-Levy et al. ("hereinafter Cohen-Levy").

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8 and 12, 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "an application managing method for a case where a plurality of applications are stored in a storage at location of the storage" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "an information processing apparatus" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1, 3-8 and 12, 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Art Unit: 2172

Claims 1 and 12, in view of the above cited MPEP section, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,661,800 issued to Nakashima et al. ("hereinafter Nakashima") in view of U.S. Patent No. 5,423,034 issued to Cohen-Levy et al. ("hereinafter Cohen-Levy").

As per claim 12, Nakashima discloses "an information processing apparatus, storing a plurality of applications at locations of a storage" (see col. 16, lines 8-12), comprising:

"a directory structure in the storage corresponding to the plurality of applications" (see col. 9, lines 1-4);

Art Unit: 2172

"wherein in the storage items of identification information of the application addresses are directly given to predetermined directories of the directory structure, respectively" (see col. 10, lines 37-40),

"the ~~items of identification~~ application address information being used for identifying the ~~plurality of applications~~, respectively" (see col. 5, lines 64-65),

"wherein an address of the plurality applications are the items of identification information" (see col. 16, lines 8-12). Nakashima fails to explicitly disclose where the plurality of applications are needed for corresponding to data files stored in the storage using the predetermined directories of the directory structure. However, Cohen-Levy discloses predetermined directory name will identify those storage devices that contain information recognized by the real world hierarchical data structure and will determine which directories of those storage devices contain recognized information (see col. 12, lines 53-63). [It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Nakashima and Cohen-Levy with applications are needed for corresponding to data files stored in the storage using the predetermined directories of the directory structure. Such modification would allow the teachings of Nakashima and Cohen-Levy to provide the user with an interface to enable the user of the application program to communicate with the program (see Cohen-Levy col. 1, lines 62-64).

As per claim 14, Nakashima discloses, "an application management table that stores the items of identification information and starting addresses of the plurality of

Art Unit: 2172

applications, the plurality of applications corresponding to the items of identification, respectively (col. 4, lines 6-41).

As per claim 15, Nakashima discloses, "wherein an item of the items of identification information is given to the highest directory of the directory structure" (see col. 4, lines 6-30).

As per claim 16, discloses, the limitations of claim 16 are rejected in the analysis of claim 12, and this claim is rejected on that basis.

Allowable Subject Matter

9. The following is a statement of reasons for the indication of allowable subject matter:

As per claims 1 and 3-8, the claimed features "performing management so that when one of the data files is selected a needed application corresponding to the data file of a directory of the predetermined directories is selected and executed by referring to the selected data file's directory to obtain its application's address information and therewith access and execute the application at the storage location of the thus-obtained address information given to the directory, where the selection for execution is responsive to the data file of the directory being selected" in conjunction with other elements of the independent claims are not found as anticipated or obvious over the prior art made of record.

Art Unit: 2172

CONTACT INFORMATION

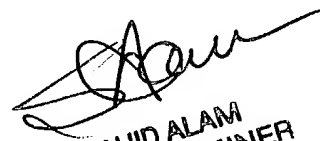
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 703 - 308-6718. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 703 - 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean Bolte Fleurantin

16 September 2004


SHAHID ALAM
PRIMARY EXAMINER